

REMARKS

Claims 1 to 7, 23, 26 to 32 and 35 to 42 were pending in the application at the time of examination. Claims 8 to 22, 24, 25, 33, and 34 were previously withdrawn. Claims 1 to 7, 23, 26 to 32 and 35 to 42 stand rejected as obvious.

Applicant(s) have amended the description to correct a typographical error.

The responsibility for the above application has been transferred to the undersigned attorney. Please address all future correspondence in the above application to the undersigned attorney. A revocation of attorney and appointment of new attorney will be filed under separate cover.

Claims 1, 5-7, 23, 26, 30-32, 35, 36 and 40-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,536,035 B1, hereinafter referred to as Hawkins, in view of "JDK 1.2 Roadmap: All Things New with JDK," hereinafter referred to as Pawlan. The Examiner stated in part:

In regard to Claim 1, Hawkins teaches: (a) executing a main program unit a first time (Column 8, lines 5-6); (b) creating at least one library file containing application program files loaded during first execution of the main program unit. Hawkins teaches analyzing, tracing, and archiving application classes in a library file. Specifically, Hawkins teaches "analyzing a running application to trace the first instantiation of classes with the application" (emphasis added) (Column 8, lines 5-6). Therefore the library file created by Hawkins contains only application class files. (c) executing said main program unit a second time using at lease [Sic] . . .

Applicants respectfully traverse the rejection. Applicants respectfully submit that the rejection makes inferences and modifications to the reference that are neither taught nor suggested by the passages cited and the rejection ignores explicit claim limitations.

The MPEP requires that:

**PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING
DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS**

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

MPEP § 2141.02, Eighth Edition, Rev. 2, p. 2100-127 (May 2004).

The MPEP further requires:

THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED

MPEP § 2141.02, Eighth Edition, Rev. 2, p. 2100-124 (May 2004);

and further:

**DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN
INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT**

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, Eighth Edition, Rev. 2, p. 2100-125 (May 2004).

Column 8, lines 5-6 of Hawkins state:

analyzing a running application to trace the first instantiation of classes within the application;

First, this quote does not suggest or teach anything concerning a "main program unit," but rather "the first instantiation of classes within the application." Typically, an application contains more than the "main program unit." Therefore, Hawkins teaches away from a "library file containing only application program files loaded during said first execution of said main program unit," (Emphasis added) when taken as a whole as required by the MPEP as quoted above.

Further, the Examiner apparently assumes that "application program files" equates to "classes." If the application program is written in the C programming language for example, classes are not typically used. The Examiner has cited no teaching or justification for this analogy. Again, the MPEP requires that the claim limitations and the prior art be considered as a whole.

Next, the Examiner assumes that "first instantiation of classes" equates to "only application program files loaded during said first execution of said main program unit." Again, according to Hawkins, if an application program file did not include "the first instantiation of a class," it is not considered further in the quote relied upon in the rejection.

Accordingly, even assuming that the Examiner's interpretation were correct, it still teaches away from Applicant's invention, because Hawkins would miss all application files that were loaded but did not contain a first instantiation of a class. It is clear that the Claims have been reduced to a gist, which is an improper form of analysis as noted by the above quote from the MPEP.

Next, it was previously pointed out that "If a system program file was, for example, executed in the very first line of the main program code, . . ." The examiner apparently considers anything within an application to be "an application file." Again, this ignores nomenclature commonly used in the art, and ignores the explicit differences between the terms defined in the claims and the terms defined by Hawkins and so fails to consider either as a whole.

Next, the Examiner proposes modifying Hawkins. However, Hawkins taught how to successfully use the invention. See Hawkins, Column 5, lines 57 to Col. 6, line 2. Despite this explicit teaching, the Examiner uses the terms in Applicants' claims and not any teaching in either reference to modify Hawkins. First, given the cited Hawkins teachings, there would

be no motivation to modify Hawkins. The Examiner has cited nothing in either reference that suggests that Hawkins requires or needs modification. Again, the MPEP specifically proscribes this type of modification by stating:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests** the desirability of the combination. (Emphasis Added.)

MPEP § 2143.01, Eighth Edition, Rev. 2, p. 2100-131 (May 2004).

If the Examiner continues this rejection, the Examiner is respectfully requested to cite with specificity the teachings in the prior art that suggest the need for modification, and that the teachings that Hawkins would work with the proposed modification.

Applicants have demonstrated numerous reasons why the obviousness rejection of Claim 1 is not well founded. Any one of the reasons is sufficient to overcome the obviousness rejection. Accordingly, Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 5 to 7 include the limitations of Claim 1 upon which they depend. Accordingly, each of Claims 5 to 7 distinguish over the cited combination at least for the same reasons as discussed above for Claim 1, which are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 5 to 7.

Claim 23 includes limitations similar to those discussed above for Claim 1 and so the remarks concerning Claim 1 are incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 23.

Claim 26 includes limitations similar to those discussed above for Claim 1 and so the remarks concerning Claim 1 are incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 26.

Claims 30 to 32 include the limitations of Claim 26 upon which they depend. Accordingly, each of Claims 30 to 32 distinguish over the cited combination at least for the same reasons as discussed above for Claim 26, which are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 30 to 32.

In the rejection of Claim 35, the Examiner again equates "first instantiation of classes" with "every application program unit loaded." As noted previously, according to the rejection, an application program unit that did not include a first instantiation of a class would not be processed by Hawkins and so Hawkins teaches away from "every application program unit loaded." Further, the remainder of the rejection is based upon conclusory statements without citation to prior art. The Examiner has not even attempted to use "Official Notice." If the Examiner continues this rejection, the Examiner is respectfully requested to back up each of the conclusions in the rejection with citations to the prior art that comply with the requirements stated in the MPEP including those sections quoted above. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 35.

Claim 36 includes the limitations of Claim 35 upon which it depends. Accordingly, Claim 36 distinguishes over the cited combination for at least the same reasons as discussed above for Claim 35, which are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 36.

Claims 40 to 42 include the limitations of Claim 23 upon which they depend. Accordingly, each of Claims 40 to 42 distinguish over the cited combination at least for the same reasons as discussed above for Claim 23, which are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 40 to 42.

Claims 2 to 4, 27 to 29, and 37 to 39 stand rejected as obvious over Hawkins in view of Pawlan, and further in view of Weber. In each of these rejections, the Examiner has combined three references without citing any need for a modification to the primary reference. Further, the rejections are not based upon the teachings from the prior art, but instead use Applicants' claim language as a roadmap for selectively removing elements from three different references and then recombining them in a different form without citation to any prior art that provides a motivation for the selective choices and subsequent selective uses.

Moreover, even if the combination were correct, the additional information does not overcome the shortcomings of the primary references as noted above with respect to the claims upon which these claims depend. Those comments are incorporated herein by reference. Accordingly, Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 4, 27 to 29, and 37 to 39.

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Amdt. dated September 14, 2004
Reply to Office Action of June 15, 2004

Claims 1 to 7, 23, 26 to 32 and 35 to 42 remain in the application. Claims 8 to 22, 24, 25, 33, and 34 were previously withdrawn. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

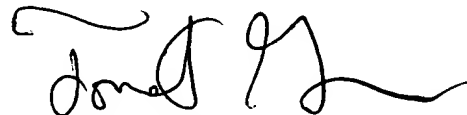
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 14, 2004.


Attorney for Applicant(s)

September 14, 2004
Date of Signature

Respectfully submitted,



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